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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,403	07/03/2003	Donald Fenstermaker	87762.0015	3587

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STEPTOE & JOHNSON LLP
Stuart T.F. Huang - Box USPTO
1330 Connecticut Avenue, NW
Washington, DC 20036

EXAMINER

MCCORMICK, GABRIELLE A

ART UNIT	PAPER NUMBER
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3629

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11/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/612,403	Applicant(s) FENSTERMAKER ET AL.	
	Examiner Gabrielle McCormick	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/9/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on July 3, 2003.
2. Claims 1-17 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on September 9, 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-17** are rejected under 35 U.S.C. 102(e) as being anticipated by Hickey et al. (US Pub. No. 2002/0107849 hereinafter referred to as "Hickey").
6. **Claim 1:** Hickey discloses a scholarship search service that performs matches between student profiles and relational databases containing scholarship data provided by universities and other sponsors via a third-party provider. The student selects search criteria and filter criteria. The student can access the scholarship search service via a university web site that matches other sites provided by the university. In this way, the web site is "branded" to the university and the university is further able to control the scholarship content provided to the student. (para. [0015], [0017] and [0047]). Specifically, Hickey discloses:

- *providing a pool of databases comprising one or more databases, the pool of databases being logically partitioned, the pool of databases containing entries from a plurality of customers;* (para. [0020]: "relational databases" (*pool of databases*): Note: relational databases inherently are comprised of multiple tables (each its own database) and operate by using predefined categories for data storage; para. [0027]: Hickey discloses matching data between a student and scholarships **in a particular scholarship database**. This teaching also inherently discloses multiple scholarship databases. In para. [0023]: multiple institutions communicate with the server; scholarships are accessed from a universal scholarship database within database 122 (*plurality of customers and containing entries*). In para. [0051] Hickey discloses national scholarships such as the Federal PLUS and in para. [0047] Hickey discloses *local* scholarships as those "sponsored by the university itself")
- *receiving, through a computer network, a first request formed by a first customer to insert an entry identifying a scholarship into one or more of the national section and a first local section;* (para. [0023]: institutions communicate over the Internet to the provider; para. [0052]: sponsor scholarships are entered)
- *inserting the entry into the pool of databases, the entry being inserted into the pool of databases consistent with the first request;* (para. [0052]: the capability to update inherently provides for entry of data.)
- *receiving a second request to search for scholarship information, the second request sent by a user through a web site associated with the first customer;* (para. [0046]: search is conducted via university web site)
- *searching for scholarship information consistent with the second request, a scope of said searching having a dependency on at least the web site associated with the first customer, the dependency resulting in the scope of said searching including the first local section associated with the first customer;* (para. [0047]: "the sponsor institution can provide to its students a scholarship search service that conforms to desired characteristics (*scope*) of the institution." This causes the university's filter to be applied to the search criteria used by the

student and results in delivering scholarships sponsored by the university only to the students accessing through its website.)

- *receiving a third request to search for scholarship information, the third request sent by the user through a web site associated with a second customer;* (para. [0046])
- *searching for scholarship information consistent with the third request, a scope of said searching having a dependency on at least the web site associated with the second customer, the dependency resulting in the scope of said searching excluding the first local section associated with the first customer;* (para. [0047]: as discussed above, a given university's filter would result in delivering scholarships it sponsors only to students accessing through its website. It is disclosed that a student accessing through the Georgia State University website would be provided with scholarships sponsored by Georgia State (customer 1). It is inherent therefore that a search via a different university (customer 2) website would therefore not deliver scholarships from Georgia State. "...it may wish to **only make available to its students** scholarships being sponsored by the university itself.")
- *searching for scholarship information consistent with said second request produces any match between a student and scholarship information.* (para. [0027]: "matching user information with scholarship criterion for the scholarships in a particular scholarship database.").

7. Hickey does not teach a *national* or *local* section of the databases. However, as stated above, a relational database is comprised on multiple tables (databases) for data storage by category. This is inherent in a relational database. It is obvious that the relationship between the tables and the categories would be differentiated based on data type, such as scholarship type. The name of the section is a difference only found in the **nonfunctional descriptive data** and is not functionally involved in the steps recited. **The inherent functionality of the relational database to store, search and match data based on student information and scholarship type would be performed regardless of the name of the database.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703

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F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a national and a local section of the database because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the name of the database does not patentably distinguish the claimed invention.

9. **Claim 6:** Hickey discloses:

- *providing a first pool of databases comprising one or more databases, the first pool of databases containing entries from a plurality of sources, each entry being associated with a specific source and identifying a scholarship;* (para. [0020]: scholarships are stored in relational databases and Figure 3D: example of scholarship data).
- *receiving, from a plurality of users, a plurality of requests to search for a scholarship, each request formed by a user, each request associated with a student and comprising personal information associated with that student;* (para. [0034]: personal student information provided in request)
- *searching, with respect to each request, for scholarship information consistent with said receiving;* (para. [0028])
- *storing, in a second pool of databases comprising one or more databases, personal information specific to each student associated with a request;* (para. [0034]: information is stored and para. [0020]: "relational databases" (*pool of databases*): Note: relational databases inherently are comprised of multiple tables (each its own database) and operate by using predefined categories for data storage;)
- *providing demographic information derived from the second pool of databases;* (para. [0034]: the information is provided when it is used to filter scholarships)
- *searching produces any match between a student associated with each request and scholarship information, and whereby said providing results in a recipient receiving reliable demographic information;* (para. [0027]: matches are performed between the student

demographic information (gender, age education, residency) and the scholarship database.

The *recipient* is the third-party provider discloses in para. [0031]).

- *each request is formed on a web page hosted by an entity and a scope of said searching is at least partially dependent on stipulations of the entity.* (para. [0046-0047]: the scholarship search web site has the "look and feel" of of a given university which also instructs the third-party service provider to present specific data.)

10. Claims 9 and 14: Hickey discloses:

- *scholarship data comprising national scholarship data and local scholarship data;* (para. [0051] Hickey discloses national scholarships such as the Federal PLUS and in para. [0047] Hickey discloses *local* scholarships as those "sponsored by the university itself")
- *receiving a first search request from a user, the first search request comprising a first search criteria;* (para. [0033])
- *searching, in association with a first web site, the scholarship data based on at least the first search criteria; returning first search results, through the first web site, the first search results including matches between the first search criteria and the national scholarship data, and omitting matches between the first search criteria and the local scholarship data;* (para. [0047]: "the sponsor institution can provide to its students a scholarship search service that conforms to desired characteristics of the institution." This causes the university's filter to be applied to the search criteria used by the student and results in delivering scholarships sponsored by the university only to the students accessing through its website. Therefore, if access is through a different website, the "local" Georgia State scholarships would not be displayed. Para. [0031] discloses "CollegeNET" as a third-party scholarship search provider. Para. [0028] discloses "unavailable scholarships filtered out based on the initial filter information", i.e., scholarships "local" to a given state would be filtered out based on the residency requirement.)

- *customer-specific web site access to the scholarship data; receiving a second search request, from the customer-specific website, the second search request comprising a second search criteria; (para. [0046]: search is conducted via university web site)*
 - *searching the scholarship data based on at least the second search criteria; and returning second search results via the customer-specific web site, the second search results including matches between the second search criteria and the national data, matches between the second search criteria and the local data as authorized by an associated at least one customer, and omitting matches between the second search criteria and the local data that are unauthorized by an associated at least one customer. (para. [0047]: "the sponsor institution can provide to its students a scholarship search service that conforms to desired characteristics of the institution." This causes the university's filter to be applied to the search criteria used by the student and results in delivering scholarships sponsored by the university only to the students accessing through its website. It is disclosed that a student accessing through the Georgia State University website would be provided with scholarships sponsored by Georgia State (customer 1). It is inherent therefore that a search via a different university (customer 2) website would therefore not deliver scholarships from Georgia State. "...it may wish to **only make available to its students** (provides authorization) scholarships being sponsored by the university itself.")*
11. **Claim 2:** Hickey discloses *national scholarships*. (para. [0051]: Federal PLUS and Federal Stafford are examples of scholarships that have no residency or institutional requirement.)
12. **Claim 3:** Hickey discloses *student information*. (para. [0021]).
13. **Claims 4, 7, 13 and 17:** Hickey discloses "grants, loans, awards and other financial aid" (para. [0003]).
14. **Claim 5:** Hickey discloses *searching the national section of the pool of databases*. (para. [0050] and [0051]: an example of a search conducted where the institution chose to include all of the possible scholarships includes displaying Federal PLUS and Federal Stafford. It is inherent that the search included searching *national* scholarships.)

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15. **Claim 8:** Hickey discloses *providing demographic data to a third party*. (para. [0027]: matches are performed between the student demographic information (gender, age education, residency) and the scholarship database. The *recipient* is the third-party provider discloses in para. [0031]).
16. **Claim 10:** Hickey discloses prioritizing matches. (para. [0030]).
17. **Claims 11 and 15:** Hickey discloses *the first search criteria and second search criteria are the same, and the first search results are different from the second search results*. (para. [0029]: the search criterion remain the same, however the results are impacted based on the filters.)
18. **Claims 12 and 16:** Hickey discloses *a plurality of customer-specific websites*. (para. [0017]: the scholarship service website of a sponsor institution (university) is "branded" to match **other sites** provided by the institution.)

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
20. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

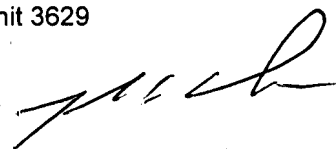
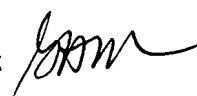
Scholarship Experts (pages documented at the Internet Archive from September 24, 2001;
<http://web.archive.org/web/20010417231246/www.scholarshipexperts.com/pricing3.jsp>;
<http://web.archive.org/web/20011003224455/www.scholarshipexperts.com/providers.jsp>;
<http://web.archive.org/web/20010405132347/www.scholarshipexperts.com/about.jsp>).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is 571-270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gabrielle McCormick
Patent Examiner
Art Unit 3629



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600